OIPE
MAR 12 2009
PATENT & TRADEMARK OFFICE
AP81

DOC Code: AP.PRE.REQ

PTO/SB/33 (08-08)
Approved for use through 09/30/2008. OMB 0651-0031
United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
059643.00353

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
Name _____

Application Number:

10/702,051

Filed: November 6, 2003

First Named Inventor:

Jorge MELGOSA

Art Unit: 2617

Examiner: Charles Terrell Shedrick

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

Peter Flanagan
Signature

☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

Peter Flanagan
Typed or printed name

☒ Attorney or agent of record.
Registration No. 58,178

703.720.7864
Telephone number

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____

March 12, 2009
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OIPE
MAR 12 2009
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Confirmation No.: 7417
Jorge MELGOSA	Art Unit: 2617
Application No.: 10/702,051	Examiner: Charles Terrell Shedrick
Filed: November 6, 2003	Attorney Dkt. No.: 059643.00353

For: COMMUNICATIONS SYSTEM FOR CHARGING A COMMUNICATION SESSION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 12, 2009

Sir:

Applicant hereby submits this Pre-Appeal Brief Request for Review ("PABRR") of the final rejections of claims 1, 4-11, 13, and 19-41 in the above identified application. Claims 1, 4-11, 13, and 19-41 were finally rejected in the Final Office Action dated December 12, 2008 ("Office Action"). Applicant filed a Response to the Office Action on February 9, 2009 ("Applicant's Response"). The Office issued an Advisory Action dated March 2, 2009 ("Advisory Action"). Applicant hereby appeals these rejections and submits this PABRR. A Notice of Appeal is timely filed concurrently herewith.

The Office Action rejected claims 13 and 19-41 under 35 U.S.C. §103(a) as being allegedly unpatentable over 3GPP TS 32.215v 4.00 (2001-09), ("3GPP") in view of WO 02/098099 of Lialiamou *et al.* ("Lialiamou"). The Office Action acknowledged that 3GPP does not disclose all of the features of the rejected claims and cited Lialiamou to remedy the deficiencies of 3GPP. Applicant respectfully traverses this rejection.

A very detailed response to this rejection can be found at page 11-18 of the Response. Nevertheless, the following serves to set forth succinctly the clear errors in the rejection.

Clear Error 1: 3GPP does not disclose what is has been cited for

The 3GPP specification generally relates to charging management, and more specifically to a charging data description for the packet switched (PS) domain. 3GPP does not disclose or suggest:

- "identifying one of said charging nodes as being a default charging node" (as recited in claim 1); or
- charging information being sent to the default charging node "when said default charging node is available" (as also recited in claim 1)

The Office Action did not explicitly identify these features of the claims. Furthermore, it is respectfully submitted that, in 3GPP, there is no disclosure of a charging node at all. The Examiner is invited to state explicitly where this feature is found with reference to specific text in 3GPP. The Office Action referred generation to Annex A and certain paragraphs thereof, but these portions of 3GPP do not mention a charging node. The Advisory Action has pointed to a reference at page 6 of 3GPP mentions a single "Charging Gateway" (for some reason, the Advisory Action omitted the word "Function" from the description of the Charging Gateway Function (CGF) at page 6 of 3GPP). Of course, this was not relied-upon in the initial rejection and consequently cannot support the ground of rejection presented.

Additionally, the Advisory Action stated that page 56 of 3GPP states that "the profile may also specify an optional charging gateway address."

Apparently, the Advisory Action reflects the view that a "Charging Gateway" is equivalent to a "charging node" within the meaning of the claim. This is not actually clearly stated anywhere in the Office Action or Advisory Action, but it is Appellant's best understanding based on the limited record.

However, as indicated in the response, the claim calls for at least three concepts:

i) charging node;

ii) a further charging node; and

iii) a default charging node.

There is mention of a default CGF address in the first paragraph of page 56 of 3GPP. However, the "default CGF address" is used in 3GPP only when an SGSN does not have a CGF

address in its own selected charging characteristics trigger profile. Furthermore, this is a default address rather than specifically a default node.

Nevertheless, even if it could be agreed that the "default CFG address" corresponded to a "default charging node" the rejection would still be clearly erroneous, whether or not the Advisory Action's definition of default as "the option that is automatically assigned unless overridden" is correct (not admitted). Assuming, for the sake of the argument, that the "default CGF address" meets the Advisory Action's definition of "default," there is no teaching that the availability of the CGF corresponding to the address is a factor in overriding the selection of the CGF. In fact, contrary to the claims, if the profile of the GGSN (or the SGSN) has any address in it, that address is used, and the default address is not used.

Thus, there is no disclosure in 3GPP of charging information being sent to the default charging node "when said default charging node is available" (as also recited in claim 1).

Additionally, even if the default CGF address were to correspond to a default charging node, 3GPP provides no teaching regarding actually "identifying one of said charging nodes as being a default charging node" (as recited in claim 1). In fact, there is no explicit disclosure of there being more than one CGF in 3GPP.

Clear Error 2: Application of Lialiamou to the Claims Makes No Sense

As far as the Office Action's reference to Lialiamou is concerned, Applicant respectfully submits that the Office Action has referenced only a part of a claim feature, and has done so in such a way that the claim feature does not make sense.

Specifically the Office Action refers to "a period during which said default charging node is unavailable regardless of availability of any other charging node." This way of breaking up the claim makes little grammatical sense. Specifically, it is respectfully submitted that in the broadest reasonable interpretation of the claim, the clause "regardless of availability of any other charging node" modifies the verb "send."

As presented in the Office Action, however, it is unclear whether the Office Action reflects a proper understanding of the claim, or whether the Office Action has misinterpreted the clause to some how to refer to the "unavailable" status of the default charging node. Unfortunately, because the Office Action lacks an explanation of the rejection, it is unclear

whether the Office Action has simply quoted the claim terminology in an unusual way, or whether the Office Action has made a fundamental error in grammatically parsing the claim. If it is the latter case, it is respectfully submitted that (from a grammatical standpoint) the only available referent for the clause "regardless of availability of any other charging node" is the verb "send," such that the claim recites that "said first node and said second node are configured to send [the information to the default node] regardless of availability of any other charging node."

In case the Office Action has properly understood the claim, and has viewed Lialiamou as corresponding to what is recited in the claim, Applicant respectfully disagrees. Figure 4 of Lialiamou (cited in the Office Action) does not make any reference to any configuration where charging information is sent to a default charging node using information stored in a memory, where the default charging node is available, and where this availability is after a period during which the charging node is unavailable regardless of availability of any other charging nodes.

The Office Action has further made vague reference to "description," without explaining how the "description" is alleged to correspond with what is claimed.

With reference to the sub-claims, the Office Action referred to specific pieces of description, but again, in these there is no reference to gateways as being charging gateways/nodes (which appears to be the Office Action's unstated premise). Should the Office Action persist in using Lialiamou, it is respectfully requested that the Office Action identify where, in this document, there is any reference to

a) a charging node;

b) more than one charging node;

c) a default charging node;

d) where the nodes are configured to send respective charging information for a session to a default charging node using information stored in the first memory and where when said default charger node is available, after a period during which said default charging node is unavailable regardless of availability of any other charging node; and

e) why one of ordinary skill in the art would wish to incorporate Lialiamou with 3 GPP.

It is respectfully submitted, therefore, that even if the references were combined, several features of each of the independent claims would not be found in the applied combination (as

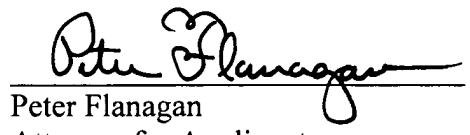
proven above). Furthermore, the Office Action has not established a reason (such as teaching, motivation, or suggestion) that one of ordinary skill in the art would have found to combine the references. The Office Action at (for example) page 3, simply asserts that it would be obvious to combine the references, but does not state (much less establish based on evidence) why such a combination would be obvious.

In *KSR* (*KSR Int'l Co. vs. Teleflex, Inc.*) the Supreme Court reiterated the Federal Circuit's instructions, *In re Kahn*, 441 F. 3d 977, 988, (Fed. Cir. 2006) that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, slip op. at 14. In this case the rejection lacks articulated reasoning rational underpinnings that support the legal conclusion of obviousness, and, thus, the rejection should be withdrawn.

The distinctions above have been presented with respect to the specific recitations found in claim 1. The same or similar problems are present with respect to each of the rejections of each of the claims, each of which has its own respective scope.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Peter Flanagan
Attorney for Applicant
Registration No. 58,178

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
8000 Towers Crescent Drive, 14th Floor
Vienna, Virginia 22182-6212
Telephone: 703-720-7800, Fax: 703-720-7802
PCF/dlh
Enclosures: PTO/SB/33 Form, Notice of Appeal, Check No. 000020577